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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/980,636 | 08/29/2002 | John V Briel | 36-1642 | 7111 |

7590 02/26/2004

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EXAMINER

HARLE, JENNIFER I

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,636

Applicant(s)

BRIEL ET AL.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/29/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-10 are pending. Claims 1-10 are rejected.

Claim Rejections - 35 USC § 112

Although Applicant(s) use “means for” in the claim(s) (e.g. claim 1), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th Paragraph*.¹

Failure by Applicant(s) to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

¹ Federal Register Vol. 65, No 120, June 21, 2000.

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Claims 1-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Koreeda (5,890,137).

As per claim 1, Koreeda discloses, an online shopping system's configuration, i.e. data management system, which is used in receiving and processing data in relation to multiple products for multiple stores, and records the product selection, payment, and delivery processing as it pertains to the ordered product, i.e. in respect of a generated product description (Abstract, Fig. 1);

the system comprising:

an input for product selection data (Fig. 1 – Shop System/Service Center, Fig. 10 – Service Center – Shop A's Business Terminal, Fig. 14 – Product Data; cols. 5-6, lines 1-19; the product data initially had to come from the shop system as it is part of their inventory, as would new additions, etc.);

a marketplace product store for storing marketplace product definitions (Fig. 1 – Service Center; cols. 5-6, lines 1-19);

a product selection store for storing data defining a selection of one or more products from the market place product store (Fig. 1 – Product Selection Unit/Accumulation Unit);

an enterprise capability store for storing data defining capability of an enterprise in relation to supply of one or more products (Fig. 1 – on-line shopping system); and

a product fulfillment data store for storing one or more product descriptions (Fig. 1 – Delivery Processing Unit);

wherein there is further provided means to generate

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at least one link between each product description in the product fulfillment data store to data stored in the enterprise capability store (Fig. 1 – links between all components are shown and as the enterprise capability store, i.e. the online shopping system – the means to link set forth as a computer network, which can connect through the Internet and communication lines, see, e.g. cols. 5-6)

at least one link between each product description in the product fulfillment data store to data stored in the product selection store (Figs. 1 and 3, see, e.g. cols. 5-6 and 11).

As per claim 2, Koreeda discloses the specified data in the enterprise capability store relates to equipment necessary to support provision of a product identified in the product description (Figs. 1 and 3, including Approval center/payment collection unit, Product Delivery, Payment, Settlement Network, Invoicing, Appropriate software transfer to user).

As per claim 3, Koreeda discloses that the product description includes order time, order expiration, and inventory information, i.e. date information together with availability date data, and the system further comprises means to review the availability date data against the date information, such that a valid product description is dependent upon compatibility between the availability date data and the date information (Figs. 3 and 14, cols. 6, 9-10 – the product download is performed each time the user utilizes the program and the product confirmation unit makes the user decide what products to buy and also is reloaded each time and thus updated information would be based upon availability, and the information is reconfirmed after the user clicks OK; the means is the repetitive download and the reconfirmation.).

Koreeda discloses claim 4 for the same reasons set forth in claim 3.

As per claim 5, Koreeda discloses a means to generate a link between each marketplace product definition stored in the marketplace product store to data stored in the enterprise capability store, said links being determined by a requirement in the respective marketplace product definition for specified data in the enterprise capability store, such that a valid marketplace product definition is dependent on presence of said specified data in the enterprise capability store (Koreeda links each marketplace product definition in the service center with definitions throughout the shopping system, i.e. enterprise capability store, and if each of the data is not present then there is no transaction, i.e. a valid marketplace product definition depends on presence of specified data in the online shopping system – mean to generate a link can be a computer network, the Internet, communications links - Figs. 1-3, 9A, 9B, and 10-15; cols 5-11).

Koreeda discloses claim 6 for the same reasons a claim 3 and 5, i.e. updates are taught in claim 3 and the links are set forth in claim 5.

Method claim 10 is rejected for the same reasons set forth in system claims 1 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda (5,890,137) as applied to claims 1 and 5 above, and further in view of Blinn, et al. (5,897,622 which incorporates by reference 5,974,418).

As per claim 7, Koreeda discloses as set forth above in claim 1. Koreeda further discloses that items may be sold as sets (Fig. 6) and discloses product descriptions (Fig. 14). However, Koreeda does not disclose that data in the enterprise capability store comprises identifiers for instances of apparatus available to support a product identified in a product description. Blinn, et al. discloses the ability to recommend related items to purchasers, i.e. cross selling through utilizing identifiers for instances of apparatus available to support a product identified in a product description (Figs. 13A and 13B; cols. 17-19, lines 18-15). Blinn, et al. further discloses that in order to effectively promote their products merchants utilize a wide variety of discounting schemes, including cross-selling and that merchants desire an online system that allows for a significantly wider variety of product discounting and sales schemes. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the ability to recommend related items to purchasers through the mechanism taught in Blinn, et al. in Koreeda for the specific reasons taught in Blinn, et al.

As per claims 8 and 9, Koreeda discloses as set forth above. However, Koreeda does not disclose a means to update the specified data in the enterprise capability store and to make consequent changes to links relevant to that data. Blinn, et al. discloses administrative actions accessibly by the system administrator to provide for management of the merchant system, including actions that enable the merchant to create pages to access the database to insert, delete and update database information through the use of modify the queries stored in the database instead of modifying the system modules, thus ensuring consistent changes throughout the system and negating the need to modify application every time a merchant modifies the database, i.e. this is a means to specified data in an enterprise capability store and to make consequent

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changes to links relevant to that data (col. 3, lines 2-18; cols. 9-10, lines 55-4; cols. 12-14, lines 57-61). Blinn, et al. further discloses that the ability to change the data easily permits the merchant to effectively promote their products and also to guarantee the shopper consistency and reliability in the information used to make purchasing decisions (col. 3, lines 19-30). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the query system of Blinn, et al. in the system of Koreeda to effectuate updates/deletions in specific data in the database - online store or servicing center, i.e. the enterprise capability store or market product definition, and thus make changes to links relevant to that data for the specific reasons set forth in Blinn, et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Garretson (US 2001/0047306 A1) discloses an electronic merchant system that has a database server, store server, update terminal, order display terminal, raincheck system, inventory change, etc.

Kohdoh, et al. (US 2001/0053677 A1) discloses a cybermall system with the flow of process and data.

Arora, et al. (US 2002/0013760 A1) discloses a system and method for implementing electronic markets, including a market generation system.

Arora, et al. (US 2002/0032638 A1) discloses an efficient interface for configuring an electronic market, including the various databases, links, etc.

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Imamura, et al. (6,128,600) discloses an electronic shopping system and method of defining electronic catalogue data, including defining products with respect to their essential parts and optional items necessary to define optional products.

Yagasaki (6,125,353) discloses a mall server with product search capability, including date codes, registration of production information to the to the mall servers from a member company, product delivery and payment, etc.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"² the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,³ the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.⁴ By addressing these issues

² Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

³ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

⁴ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

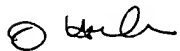
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now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Ione Harle
February 22, 2004